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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,507	12/04/2003	Stephen R. Nichols	END920030084US1	9119

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EXAMINER	
SERRAO, RANODHI N	
ART UNIT	**PAPER NUMBER**
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,507	NICHOLS ET AL.	
	Examiner	Art Unit	
	Ranodhi Serrao	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. As per claim 8, when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

4. As per claim 9, it appears that the claim would reasonably be interpreted by one of ordinary skill as a system of "software per se", failing to fall within a statutory category of invention. Applicant's disclosure contains no explicit and deliberate definition for the term "means", and in the context of the disclosure and claims in question, one of

ordinary skill would reasonably interpret the "means" as software applications. As such, the system of "means" alone is not a machine, and it is clearly not a process, manufacture nor composition of matter. Thus, the claims are not limited to statutory subject matter and are therefore nonstatutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheng et al. (2003/0046676).

7. As per claim 1, Cheng et al. teaches a method for updating first and second parameters of a recipient computer console from first and second donor computer consoles (see Cheng et al., ¶ 15), said method comprising the steps of: said recipient console registering with said first donor console to receive notification when said first donor console has an update to said first parameter; said recipient console registering with said second donor console to receive notification when said second donor console has an update to said second parameter (see Cheng et al., ¶ 54-55); after the step of registering said recipient console with said first donor console, said recipient console

receiving said notification from said first donor console and updating said first parameter from said first donor console accordingly; and after the step of registering said recipient console with said second donor console, said recipient console receiving said notification from said second donor console and updating said second parameter from said second donor console accordingly (see Cheng et al., ¶ 131-139).

8. As per claim 2, Cheng et al. teaches a method wherein said recipient computer console and said first and second donor consoles all include similar computer control software (see Cheng et al., ¶ 52).

9. As per claim 3, Cheng et al. teaches a method further comprising a second recipient console which registers with said first donor console to receive notification when said first donor console has an update to said first parameter, after the step of registering said second recipient console with said first donor console, said second recipient console receiving said notification from said first donor console and updating said first parameter from said first donor console accordingly (see Cheng et al., ¶ 44).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. as applied to claim 1 above, and further in view of Cohen et al. (7,051,091). Cheng et al. teaches the mentioned limitations of claim 1 above but fails to teach a method wherein said first parameter is a help desk phone number. However, Cohen et al. teaches a method wherein said first parameter is a help desk phone number (see Cohen et al., col. 5, lines 36-42). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cheng et al. to a method wherein said first parameter is a help desk phone number in order to configure software-containing hardware units which are serviced by a center which services a multiplicity of similar units having a plurality of different configurations (see Cohen et al., abstract).

13. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. and Cohen et al. as applied to claims 1 and 4 above, and further in view of Carroll et al. (2003/0097211).

14. As per claim 5, Cheng et al. and Cohen et al. teach the mentioned limitations of claims 1 and 4 above but fail to teach a method wherein said second parameter is an

identity of an authorized user. However, Carroll et al. teaches a method wherein said second parameter is an identity of an authorized user (see Carroll et al., ¶ 27). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cheng et al. and Cohen et al. to a method wherein said second parameter is an identity of an authorized user in order to retrieve a selection of desired service data including information needed for performing a service process (see Carroll et al., ¶ 9).

15. As per claim 6, Cheng et al. teaches the mentioned limitations of claim 1 above but fails to teach a method wherein said first parameter is an authorization of a user. However, Carroll et al. teaches a method wherein said first parameter is an authorization of a user (see Carroll et al., ¶ 27). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cheng et al. to a method wherein said first parameter is an authorization of a user in order to retrieve a selection of desired service data including information needed for performing a service process (see Carroll et al., ¶ 9).

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. as applied to claim 1 above, and further in view of Vincent (2004/0015953). Cheng et al. teaches the mentioned limitations of claim 1 above but fails to teach a method further comprising the steps of: said recipient console requesting said first parameter update from said first donor console after the step of said recipient console receiving said notification from said first donor console of said update to said first parameter, and before the step of said recipient console updating said first parameter from said first

donor console accordingly; and said recipient console requesting said second parameter update from said second donor console after the step of said recipient console receiving said notification from said second donor console of said update to said second parameter, and before the step of said recipient console updating said second parameter from said second donor console accordingly. However, Vincent teaches a method further comprising the steps of: said recipient console requesting said first parameter update from said first donor console after the step of said recipient console receiving said notification from said first donor console of said update to said first parameter, and before the step of said recipient console updating said first parameter from said first donor console accordingly (see Vincent, ¶ 51); and said recipient console requesting said second parameter update from said second donor console after the step of said recipient console receiving said notification from said second donor console of said update to said second parameter, and before the step of said recipient console updating said second parameter from said second donor console accordingly (see Vincent, ¶ 52). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cheng et al. to a method further comprising the steps of: said recipient console requesting said first parameter update from said first donor console after the step of said recipient console receiving said notification from said first donor console of said update to said first parameter, and before the step of said recipient console updating said first parameter from said first donor console accordingly; and said recipient console requesting said second parameter update from said second donor console after the step of said recipient

console receiving said notification from said second donor console of said update to said second parameter, and before the step of said recipient console updating said second parameter from said second donor console accordingly in order to efficiently distribute software and provide new functionality and other software upgrades to a large number of users (see Vincent, abstract).

17. Claims 8-10 have similar limitations as to claims 1-7 above; therefore, they are being rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are:

- Slivka et al. (6,049,671) teaches method for identifying and obtaining computer software from a network computer
- Smith et al. (6,067,582) teaches system for installing information related to a software application to a remote computer over a network
- Fawcett (6,073,214) teaches method and system for identifying and obtaining computer software from a remote computer
- Donohue (6,202,207) teaches method and a mechanism for synchronized updating of interoperating software

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RNS

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11/20/207

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER